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EXAMINER	
PHONGSVIRAJATI, POONSIN	
ART UNIT	PAPER NUMBER
3686	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary	Application No.	Applicant(s)	
	10/595,011	PAVLATOS ET AL.	
	Examiner	Art Unit	
	SIND PHONGSVIRAJATI	3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20051215*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because said abstract fails to comply with 37 CFR 1.72(b). Correction is required. See MPEP § 608.01(b).

4. The Examiner objects to the contents of the specifications, specifically the objection has been raised because the Background and Summary have been combined into the same section.

Content of Specification

(a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

(b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

(c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

(d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

(e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer

program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

(f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

(2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an

understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

(k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

(l) Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. Claims 1-10 are rejected under 35 U.S.C. 101 because data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

3. Claims 11-30 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court precedent, and recent Federal Circuit decisions, *In re Bilski U.S. Court of Appeals Federal Circuit 88 USPQ2d 1385*. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular

machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590.

4. The methods recited in claims 11-30 are not tied to a machine nor transform the underlying subject matter to a different state or thing. See Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); and Gottschalk v. Benson, 409 U.S. 63, 71 (1972).

5. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

6. A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject

matter. Here claims 11-30 fail to meet the above requirements because they are not tied to another statutory class of invention.

7. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Goetz et al. (US 6,421,650).

10. As to **Claim 1**, Goetz teaches a web-based interface for use by a healthcare provider, the interface comprising: at least one patient health record section (col. 2 lines

14-21), and a banner section, the banner section being operative to display information based on the content of the patient health record section (Fig. 6, 9-14, col. 2 lines 33-39, col. 11 line 65 to col. 12 line 31).

11. As to **Claim 2**, Goetz teaches the interface of claim 1, the banner section further comprising a prescription ordering template related to prescription information in the patient health record section (Fig. 16-24, col. 10 lines 56-67).

12. As to **Claim 3**, Goetz teaches the interface of claim 1, the banner section further comprising a product ordering template related to information in the patient health record section (Fig. 16-24, col. 10 lines 56-67).

13. As to **Claim 4**, Goetz teaches the interface of claim 1, the banner section further comprising drug information related to the prescription information in the patient health record section (col. 2 line 67, col. 11 lines 8-17).

14. As to **Claim 5**, Goetz teaches the interface of claim 1, the banner section further comprising an interactive communications portal for hosting a communications session with a drug provider, the drug provider being selected based on prescription information in the patient health record section.

15. As to **Claim 6**, Goetz teaches the interface of claim 5, the interactive communications portal further comprising one of an audio communications portal or a video communications portal (col. 7 lines 61-67).

16. As to **Claim 7**, Goetz teaches the interface of claim 1, the banner section further comprising a drug assistance request template, the drug assistance request template

being automatically generated with a patient's health information based on the content of the patient health record section (col. 5 lines 35-39, col. 9 lines 46-55).

17. As to **Claim 8**, Goetz teaches the interface of claim 1, the banner section further comprising physician-customizable drug advertising (col. 6 lines 1-19, and 65)

18. As to **Claim 9**, Goetz teaches the interface of claim 1, the banner section further comprising an alert banner, the alert banner displaying information based on possible illnesses related to the content of the patient health record section (col. 12 lines 12-16).

19. As to **Claims 11-17**, claims 11-17 substantially recites similar limitations to claims 1-10 and are rejected using the same rationale and reasoning.

20. As to **Claim 18**, Goetz teaches the method of claim 11, further comprising the step of, in response to the patient-information corresponding to a monitored illness, displaying an alert inside the banner section about the monitored illness (col. 3 lines 5-8).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650) in view of official notice.

23. As to **Claim 10**, Goetz teaches the physician component having data specifically tailored for use by the physician, such as a database of diagnoses and common illnesses but does not specifically disclose the alert banner further comprising information based on commonly misdiagnosed illnesses. However, it is well known in the art to have a display of information that alerts the user based upon information for commonly misdiagnosed illnesses, and official notice to that effect is hereby taken. It would have been obvious to one of ordinary skill in the art at the time of the invention to have alerted the user on information based on commonly misdiagnosed illnesses for the motivation for preventing incorrect treatments (col. 1 lines 37-38).

24. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650) in view of Reitberg (US 2002/0192159).

25. As to **Claim 19**, Goetz does not specifically disclose the method of claim 18, further comprising the monitored illness being a government-monitored illness. However, this practice is well known in the art as evidence by Reitberg (paragraph 98). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Goetz to monitor illness being a government-monitored illness for the motivation for safety and effectiveness of drugs in the marketplace (Reitberg, paragraph 98).

26. Claim 20-30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650) in view of Keresman (US 2001/0047281).

27. As to **Claim 20**, Goetz teaches a method of providing health services to a patient, the method comprising the steps of: providing a patient health information interface system that displays patient information (Fig. 9-12); retrieving a health record to a browser interface, the health record containing health record content (col. 2 lines 14-21); comparing the content to a database of health-related information (col. 15 lines 53-64); retrieving information from the database of health-related information that is related to the content; and displaying the health-related information in a banner via the interface (Fig. 9-12). But Goetz does not specifically teach the patient health information interface system being a web-based interface system being used via web browser. However, this practice is well known as evidence by Keresman (paragraph 37). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the disclosure of Goetz to modify the interface of Goetz to be a web-based browser interface for the motivation for processing drug prescriptions via a communications network (Keresman, Abstract).

28. As to **Claim 21**, Goetz teaches the method of claim 20, further comprising selecting the banner to perform an action (col. 9 line 61 to col. 10 line 27).

29. As to **Claim 22**, Goetz teaches the method of claim 21, further comprising the action being displaying a prescription ordering template (col. 10 lines 53-63).

30. As to **Claim 23**, Goetz teaches the method of claim 21, further comprising connecting to a drug provider over a communications network and electronically notifying the drug provider of a prescription (Abstract, col. 3 lines 8-11).

31. As to **Claim 24**, Goetz teaches the method of claim 23, further comprising the drug provider being a pharmacy (col. 6 lines 1-6).

32. As to **Claim 25**, Goetz teaches the method of claim 21, further comprising the action being initiating a communications session with a drug provider, the banner section being an interactive communications portal for the communications session (col. 2 lines 22-27, Fig. 12)

33. As to **Claim 26**, Goetz teaches the method of claim 20, further comprising connecting to a database of illnesses and displaying an alert message in the banner in response to the content being related to a monitored illness (col. 3 lines 5-8).

34. As to **Claim 27**, the combination of Goetz and Keresman does not specifically disclose the database of illnesses being a database controlled by the Centers for Disease Control. However, it is well known in the art for the Centers for Disease Control to control a database of illnesses, for instance, the CDC may update a database for an upcoming pandemic, and official notice to that effect is hereby taken. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the disclosure of Goetz and Keresman for the motivation for keeping an up-to-date database of illnesses.

35. As to **Claim 28**, Goetz teaches the physician component having data specifically tailored for use by the physician, such as a database of diagnoses and common illnesses but the combination of Goetz and Keresman does not specifically disclose the alert banner further comprising information based on commonly misdiagnosed illnesses. However, it is well known in the art to have a display of information that alerts the user based upon information for commonly misdiagnosed illnesses, and official notice to that effect is hereby taken. It would have been obvious to one of ordinary skill in the art at the time of the invention to have alerted the user on information based on commonly misdiagnosed illnesses for the motivation for preventing incorrect treatments (col. 1 lines 37-38).

36. As to **Claim 29**, Goetz teaches the method of claim 21, further comprising the action being displaying a drug assistance application (col. 5 lines 35-39, col. 9 lines 46-55).

37. As to **Claim 30**, Goetz teaches the method of claim 29, further comprising: populating the drug assistance application (col. 5 lines 35-39, col. 9 lines 46-55); connecting with a drug assistance program provider via a communications network (col. 6 lines 20-26); and sending the drug assistance application to the pharmacist (reads on "drug assistance program provider") via the communications network (Abstract).

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIND PHONGSVIRAJATI whose telephone number is (571) 270-5398. The examiner can normally be reached on Monday - Thursday 8:00am-5:00pm (ET).

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. P./
Examiner, Art Unit 3686
20 May 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686